REMARKS

Claims 1-27 have been cancelled without prejudice. New claims 28-38 have been presented. Allowance of claims 28-38 is requested in view of the following remarks.

The Examiner rejected claims 1-27 as anticipated or obvious in view of one or more of U.S. Patent No. 5,465,309 to Johnson ("Johnson"), U.S. Patent No. 4,435,778 to Cason, U.S. Patent No. 5,875,263 to Froessl, U.S. Patent 6,205,261 to Goldberg, U.S. Patent 5,829,000 to Huang, and U.S. Patent 5,999,949 to Crandall. Since claims 1-27 have been cancelled without prejudice, the Examiner's previous grounds of rejection are moot.

PATENTABILITY OF NEW CLAIMS 28-36

New claim 28 recites "search[ing] a document for a word that contains an end-of-line hyphen; creat[ing] a solution set for the word containing the end-of-line hyphen, wherein each solution in the solution set is obtained by identifying the end-of-line hyphen as either a soft-hyphen or a hard-hyphen; search[ing] a dictionary for each solution in the solution set; and . . . us[ing] the results from the dictionary search to identify the end-of-line hyphen as either a soft-hyphen or a hard-hyphen." Since claim 28 recites substantially the same limitations as claim 1 when read in view of claims 4 and 13, it does not require a new search. This can be seen as follows:

Claim 13 identifies the words recited in claim 1 (i.e., words that are ambiguous because they contain one or more "ambiguous typesetting placeholders") as words that contain one or more hyphens that are resolvable as either hard hyphens or soft hyphens. Claim 4 recites that using the dictionary to resolve the one or more ambiguous words (i.e., words containing an ambiguous hyphen) amounts to "creat[ing] a set of candidate solutions . . . ; search[ing] the dictionary for . . . each solution in the set of candidate solutions; and us[ing] the dictionary search result to resolve the one or more ambiguous typesetting placeholders in each ambiguous word." Thus, when taken together, claims 1, 4 and 13 recite all the limitations of new claim 28, namely, "search[ing] a document for a word that contains an end-of-line hyphen; creat[ing] a solution set for the word containing the end-of-line hyphen, wherein each solution in the solution

set is obtained by identifying the end-of-line hyphen as either a soft-hyphen or a hard-hyphen; search[ing] a dictionary for each solution in the solution set; and . . . us[ing] the results from the dictionary search to identify the end-of-line hyphen as either a soft-hyphen or a hard-hyphen."

To meet the limitation of searching a document for one or more words that are ambiguous because they contain an ambiguous typesetting placeholder, the Examiner relies on the Johnson patent. Thus, the applicant expects the Examiner will argue that the Johnson patent discloses "searching a document for a word that contains an end-of-line hyphen," which is one example of an ambiguous typesetting placeholder disclosed in the specification and recited in claim 13. But Johnson fails to disclose this limitation. Instead, Johnson discloses performing character recognition on an electronic document. If Johnson's character recognition algorithm fails to recognize any characters in the document, Johnson discloses inserting a "placeholder" in a temporary output document at the known location of the unrecognized character. Johnson then discloses replacing the placeholder with characters taken from a set of "indistinguishable" characters, and using a dictionary to determine the appropriate character from the set of "indistinguishable" characters.

Nowhere does Johnson disclose or even suggest searching the document for words that contain end-of-line hyphens as recited in new claim 28, or using a dictionary to resolve the hyphens as either hard hyphens or soft hyphens. In fact, Johnson never even recognizes the ambiguity problem that is posed by end-of-line hyphens, let alone the solution to the problem as disclosed in the current application and recited in claim 28. Therefore, claim 28 is patentable over Johnson, or any combination of Johnson with the other patents relied on by the Examiner to reject claims 1-27. Moreover, new claims 29-36, which depend from and contain all the limitations of claim 28 are patentable over any combination of Johnson and the other patents for the same reasons.

PATENTABILITY OF NEW CLAIMS 37-38

New claim 37 recites "search[ing] a scanned image for a character sequence in which an adjacent pair of characters is separated by an amount of white space that is larger than a kerning space but smaller than a blank space; creat[ing] a solution set for the character sequence that

includes the adjacent pair of characters separated by the white space, wherein each solution in the solution set is obtained by identifying the white space as either a kerning space or a blank space; search[ing] a dictionary for each solution in the solution set; and . . . us[ing] the results from the dictionary search to identify the white space as either a kerning space or a blank space." Since claim 37 recites substantially the same limitations as claim 1 when read in view of claims 4 and 15, it does not require a new search. This can be seen as follows:

Claim 15 identifies the words recited in claim 1 (i.e., words that are ambiguous because they contain one or more "ambiguous typesetting placeholders") as words that contain one or more white spaces that are resolvable as either blank spaces or kerning spaces. Claim 4 recites that using the dictionary to resolve the one or more ambiguous words (i.e., words containing an ambiguous amount of white space) amounts to "creat[ing] a set of candidate solutions . . . ; search[ing] the dictionary for . . . each solution in the set of candidate solutions; and us[ing] the dictionary search result to resolve the one or more ambiguous typesetting placeholders in each ambiguous word." Thus, taken together, claims 1, 4 and 15 recite all the limitations of new claim 37, namely, "search[ing] a scanned image for a character sequence in which an adjacent pair of characters is separated by an amount of white space that is larger than a kerning space but smaller than a blank space; creat[ing] a solution set for the character sequence that includes the adjacent pair of characters separated by the white space, wherein each solution in the solution set is obtained by identifying the white space as either a kerning space or a blank space; search[ing] a dictionary for each solution in the solution set; and . . . us[ing] the results from the dictionary search to identify the white space as either a kerning space or a blank space."

As before, to meet the limitation of searching a scanned image for one or more words that are ambiguous because they contain an ambiguous typesetting placeholder, the Examiner relies on the Johnson patent. Thus, the applicant expects the Examiner will argue that the Johnson patent discloses "searching a document for a character sequence that includes a white space that is larger than a kerning space but smaller than a blank space," which is one example of an ambiguous typesetting placeholder that is disclosed in the specification and recited in claim 15. But as discussed above, Johnson fails to disclose this limitation. Instead, Johnson discloses performing character recognition on an electronic document. If Johnson's character recognition algorithm fails to recognize any characters in the document, Johnson discloses inserting a

Applicant : Richard L. Sites   Attorney's Docket No.: 07844-437001 / P404
Serial No. : 09/774,191
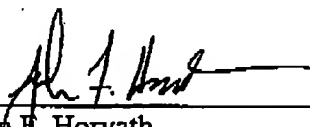Filed   : January 29, 2001
Page   : 8 of 8

"placeholder" in a temporary output document at the known location of the unrecognized character. Johnson then discloses replacing the placeholder with characters taken from a set of "indistinguishable" characters, and using a dictionary to determine the appropriate character from the set of "indistinguishable characters.

Nowhere does Johnson disclose or even suggest searching a scanned image for a character sequence in which an adjacent pair of characters is separated by an amount of white space that is larger than a kerning space but smaller than a blank space as recited in new claim 37, or using a dictionary to identify the white space as either a kerning space or a blank space. In fact, Johnson never even recognizes the problem that is posed by adjacent characters in a scanned image that are separated by ambiguous amounts of white space, let alone the solution to the problem as disclosed in the application and recited in new claim 37. Therefore, new claim 37 is patentable over Johnson, or any combination of Johnson with the other patents relied on by the Examiner to reject claims 1-27. Moreover, new claims 38, which depends from and contains all the limitations of claim 37 is patentable over any combination of Johnson and the other patents for the same reasons.

CONCLUSION

The applicant submits that claims 28-38 are in condition for allowance. No fees are believed due, however, please apply any applicable charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 6/28/05

John F. Horvath
Reg. No. 47,663

Customer No.21876

80025378.doc